

REMARKS

The non-final Office Action mailed March 19, 2008 and references cited therein have been received and reviewed. Applicant has, by this Amendment, canceled claims 3 and 4, and amended claims 1, 2, 15, 16, 53, 78 and 80.

OATH

The Examiner objected to the oath as not including a statement under Section 1.56. Applicant disagrees. The originally filed oath and declaration states that the inventor "acknowledge the duty to disclose information which is material to patentability and/or examination of this application in accordance with Title 37, Code of Federal Regulations §1.56(a)." Section 1.56(a) sets forth the obligation to an inventor whereas the other portions of the Section 1.56 define several terms in Section 1.56(a). Applicant submits that the originally filed oath is not defective.

DOUBLE PATENTING

Claims 1-4, 7, 21 and 26 were rejected on the ground of non-statutory obviousness-type double patenting over several claims of US 6,478,822. Pending claim 1 requires that the prosthetic implant include at least one expandable component. None of the components of the implant disclosed in the '822 patent are expandable. As such, the prosthetic implant defined in the pending claims are patentably distinct from the prosthetic implant defined in the claims of the '822 patent. Applicant requests that the rejection based on non-statutory obviousness-type double patenting over US 6,478,822 be withdrawn.

THE SECTION 102 AND 103 REJECTIONS

Claims 1-8, 12, 15-22, 24-33, 35-37, 39, 53, 78 and 80 were rejected under 35 U.S.C. §102(b) as being anticipated by Kuslich. Claims 14 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kuslich.

Kuslich discloses an implant 40 that consists of an expandable bag and an equatorial band 42 that limits the expansion of the bag. (Col 6, ln. 57 to Col. 7, ln. 53). The bag is expanded by inserting material into the interior of the bag. (Col. 9, lns. 13-24).

Independent claims 1, 53, 78 and 80 have been amended to require that at least a portion of the spherical or ellipsoidal body of the implant includes a non-expandable component and at least one expandable component. Kuslich discloses an implant that consists of an expandable bag. All of the components of the implant disclosed in Kuslich are expandable. As such, the teachings of Kuslich do not anticipate or make obvious any of the pending claims.

It is also arguable that band 42 disclosed in Kuslich is not an expandable component. The band 42 is designed to limit the expansion of bag 40. If such interpretation of Kuslich is adopted, none of the pending claims are anticipated or made obvious by Kuslich. Claim 1 requires an expandable stabilizer. Kuslich does not disclose an expandable stabilizer. Claim 53 requires that the expandable region in an expanded state having a larger perimeter than the non-expandable region. Band 42 of Kuslich never has a smaller perimeter than the body in an expanded or non-expanded state. Claims 78 and 80 require the non-expandable component to substantially retain its shape and form during the expansion of the at least one expandable component. Band 42 is a flexible component that changes its shape and/or form during the expansion of the bag.

Applicant submits that for at least the reasons set forth above, none of the pending claims are anticipated or made obvious by the teachings of Kuslich. A notice of allowance of the claims is earnestly solicited.

Respectfully submitted,
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